

ESTTA Tracking number: **ESTTA668995**

Filing date: **04/27/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	3M Company
Granted to Date of previous extension	04/26/2015
Address	3M Center, 2501 Hudson Road St. Paul, MN 55144 UNITED STATES
Attorney information	Wendy C. Larson Pirkey Barber PLLC 600 Congress Ave., Suite 2120 Austin, TX 78701 UNITED STATES wlaron@pirkeybarber.com, bbarber@pirkeybarber.com, eolson@pirkeybarber.com, tmcentral@pirkeybarber.com

### Applicant Information

Application No	86241947	Publication date	10/28/2014
Opposition Filing Date	04/27/2015	Opposition Period Ends	04/26/2015
Applicant	GabRy, Inc 25 Longfellow Drive Palm Coast, FL 32137 UNITED STATES		

### Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Downloadable mobile applications for sending and receiving social and business communications in the nature of short recorded voice messages


### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)


### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2012212	Application Date	11/12/1993
Registration Date	10/29/1996	Foreign Priority Date	NONE


Word Mark	POST-IT
Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1996/02/16 First Use In Commerce: 1996/02/16 computer software for creating notes and annotations


U.S. Registration No.	2371084	Application Date	09/01/1999
Registration Date	07/25/2000	Foreign Priority Date	NONE
Word Mark	POST-IT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1999/07/16 First Use In Commerce: 1999/07/16 Computer software for creating notes and annotations		

U.S. Registration No.	2372832	Application Date	09/01/1999
Registration Date	08/01/2000	Foreign Priority Date	NONE
Word Mark	POST-IT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1999/07/16 First Use In Commerce: 1999/07/16		

	Computer software for creating notes and annotations		
U.S. Registration No.	4102577	Application Date	08/31/2011
Registration Date	02/21/2012	Foreign Priority Date	NONE
Word Mark	POST-IT POPNOTES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2011/08/25 First Use In Commerce: 2011/08/25 Computer application software for mobile devices, handheld devices, tablets, and computers, namely, software for digital notes and communications		
U.S. Registration No.	1046353	Application Date	12/29/1975
Registration Date	08/17/1976	Foreign Priority Date	NONE
Word Mark	POST-IT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1974/09/25 First Use In Commerce: 1974/09/25 PAPER AND CARDBOARD SHEET MATERIAL HAVING ADHESIVE COATING ON BOTH SIDES THEREOF FOR ATTACHMENT TO WALLS OR OTHER VERTICAL SURFACES TO HOLD DISPLAYS OR OTHER MESSAGES IN PLACE		
U.S. Registration No.	1198694	Application Date	03/12/1981
Registration Date	06/22/1982	Foreign Priority Date	NONE
Word Mark	POST-IT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1974/09/25 First Use In Commerce: 1974/09/25 Stationery Notes Containing Adhesive on One Side for Attachment to Surfaces		
U.S. Registration No.	1935381	Application Date	11/14/1994
Registration Date	11/14/1995	Foreign Priority	NONE

		Date	
Word Mark	POST-IT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1994/05/24 First Use In Commerce: 1994/05/24 adhesive backed easel paper and easel pads		

U.S. Registration No.	2736421	Application Date	09/04/2002
Registration Date	07/15/2003	Foreign Priority Date	NONE
Word Mark	POST-IT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1974/09/25 First Use In Commerce: 1974/09/25 Stationery notes and note pads containing adhesive on one side of the sheets for attachment to surfaces; adhesive tape for stationery or office use; cover-up tape for paper; tape flags; printed note forms; printed notes featuring messages, pictures or ornamental designs; adhesive-backed easel paper and easel pads; bulletin boards; [ glue sticks for stationery or office use; and paper and cardboard sheet material having adhesive coatings on both sides for attachment to walls or other surfaces to hold displays or other messages in place ]		

U.S. Registration No.	3168105	Application Date	11/11/2005
Registration Date	11/07/2006	Foreign Priority Date	NONE
Word Mark	POST-IT		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 016. First use: First Use: 1974/09/25 First Use In Commerce: 1974/09/25 Stationery notes containing adhesive on one side for attachment to surfaces; printed notes featuring messages, pictures or ornamental designs; note pads, business forms, [ index cards, ] index tabs, easel paper, easel pads, sketch pads, art pads, banners of paper, page markers, bookmarks and recipe cards containing adhesive on one side of the sheets for attachment to surfaces; adhesive tape for stationery or office use; labeling tape; cover-up tape for paper; correcting tape for type; tape flags; easels; display and message boards, adhesive backed strips and geometrical shapes made from cardboard for attachment to surfaces; dry erase writing boards and writing surfaces; holders for stationery notes, notepads and tape flags; dispensers for tape flags and stationery notes for stationery use; ball point pens and highlighter pens containing tape flags; photo paper
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Attachments	75789831#TMSN.png( bytes ) 75789995#TMSN.png( bytes ) 85412185#TMSN.png( bytes ) 76446169#TMSN.png( bytes ) 78751997#TMSN.png( bytes ) noo-1.pdf(880275 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/WCL/
Name	Wendy C. Larson
Date	04/27/2015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No. 86/241,947  
Filed on April 3, 2014  
For the Mark TALKiT  
Published on October 28, 2014

3M Company,

Opposer,

v.

GabRy, Inc,

Applicant.

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Opposition No. \_\_\_\_\_

**NOTICE OF OPPOSITION**

Opposer 3M Company, a Delaware corporation located at 3M Center, 2501 Hudson Road, St. Paul, Minnesota 55114, believes that it will be damaged by registration of the mark shown in the above-identified application (the “Application”), and hereby opposes the Application under the provisions of 15 U.S.C. § 1063. The grounds for opposition are as follows:

1. Opposer develops and markets innovative products and solutions, including many consumer and office products that serve a diverse field of customers throughout the United States.

2. Opposer first introduced the POST-IT brand of adhesive-backed paper and stationery notes more than thirty years ago.



3. Since Opposer’s first use of its mark POST-IT, Opposer has continuously and extensively used the mark POST-IT in connection with a variety of highly successful consumer and office-related products, including correction tape, cover-up tape, and many other repositionable adhesive paper products.

4. Opposer also uses the mark POST-IT and related marks in connection with computer software and mobile applications for digital notes and communications.

5. Opposer's mark POST-IT is among the most famous marks in the United States, with very high brand awareness levels.

6. Opposer's mark POST-IT is widely recognized by the general consuming public of the United States as a designation of source of Opposer's goods.

7. In addition to its extensive common-law rights, Opposer is the owner of many registrations on the Principal Register of the United States Patent and Trademark Office for the mark POST-IT. Opposer's registrations include, but are not limited to, those shown in the following charts:

<b>MARK</b>	<b>Reg. No.</b>	<b>Reg. Date</b>	<b>Goods</b>
POST-IT	2012212	10/29/1996	Computer software for creating notes and annotations. (Class 9)
	2371084	5/2/2000	Computer software for creating notes and annotations. (Class 9)
	2372832	8/1/2000	Computer software for creating notes and annotations. (Class 9)
POST-IT POPNOTES	4102577	2/21/2012	Computer application software for mobile devices, handheld devices, tablets, and computers, namely, software for digital notes and communications. (Class 9)
POST-IT	1046353	8/17/1976	Paper and cardboard sheet material having adhesive coating on both sides thereof for attachment to walls or other vertical surfaces to hold displays or other messages in place. (Class 16)
POST-IT	1198694	6/22/1982	Stationery notes containing adhesive on one side for attachment to surfaces. (Class 16)
POST-IT	1935381	11/14/1995	Adhesive backed easel paper and easel pads. (Class 16)

<b>MARK</b>	<b>Reg. No.</b>	<b>Reg. Date</b>	<b>Goods</b>
POST-IT	2736421	7/15/2003	Stationery notes and note pads containing adhesive on one side of the sheets for attachment to surfaces; adhesive tape for stationery or office use; cover-up tape for paper; tape flags; printed note forms; printed notes featuring messages, pictures or ornamental designs; adhesive-backed easel paper and easel pads; bulletin boards; and paper and cardboard sheet material having adhesive coatings on both sides for attachment to walls or other surfaces to hold displays or other messages in place. (Class 16)
POST-IT	3168105	11/7/2006	Stationery notes containing adhesive on one side for attachment to surfaces; printed notes featuring messages, pictures or ornamental designs; note pads, business forms, index tabs, easel paper, easel pads, sketch pads, art pads, banners of paper, page markers, bookmarks and recipe cards containing adhesive on one side of the sheets for attachment to surfaces; adhesive tape for stationery or office use; labeling tape; cover-up tape for paper; correcting tape for type; tape flags; easels; display and message boards, adhesive backed strips and geometrical shapes made from cardboard for attachment to surfaces; dry erase writing boards and writing surfaces; holders for stationery notes, notepads and tape flags; dispensers for tape flags and stationery notes for stationery use; ball point pens and highlighter pens containing tape flags; photo paper. (Class 16)

8. Each of the registrations listed in the chart in ¶ 7 is valid, subsisting, and incontestable pursuant to § 15 of the Lanham Act, except for Registration No. 4102577.

9. Applicant GabRy, Inc., is a Florida corporation having an address of 25 Longfellow Drive, Palm Coast, Florida 32137.

10. Applicant filed the Application on April 3, 2014 for the mark TALKiT (“Applicant’s Mark”) on an intent-to-use basis pursuant to 15 U.S.C. § 1051(b) for “Downloadable



mobile applications for sending and receiving social and business communications in the nature of short recorded voice messages” in Class 9. The Application was published in the *Official Gazette* on October 28, 2014.

11. Opposer timely requested and received extensions of time until April 26, 2015, to oppose the Application.

12. Opposer’s use and registration of the mark POST-IT predate the filing date of the Application.

13. Opposer’s use and registration of the mark POST-IT predate Applicant’s first use of Applicant’s Mark.

14. Opposer’s mark POST-IT is famous within the meaning of § 43(c) of the Lanham Act.

15. Opposer’s mark POST-IT became famous within the meaning of § 43(c) of the Lanham Act before the filing date of the Application.

16. Opposer’s mark POST-IT became famous within the meaning of § 43(c) of the Lanham Act prior to Applicant’s first use of Applicant’s Mark.

17. Applicant’s Mark is very similar to the mark POST-IT in sight, sound, meaning, and overall commercial impression.

18. The goods in the Application are the same as or highly related to the goods for which Opposer uses and has registered its mark POST-IT.

19. The goods in the Application travel or will travel in the same channels of trade as Opposer’s goods offered under the mark POST-IT.

20. The goods in the Application are or will be purchased and used by the same types of consumers who purchase and use Opposer’s goods offered under the mark POST-IT.

21. Opposer has not given Applicant permission or approval to use or register Applicant's Mark.

22. Applicant's Mark so resembles Opposer's mark POST-IT as to be likely, when used on or in connection with the identified goods of Applicant, to cause confusion, to cause mistake, or to deceive. Purchasers and prospective purchasers are likely to believe that the products Applicant intends to offer under Applicant's Mark are produced, sponsored, endorsed, or approved by Opposer, or are in some way affiliated, connected, or associated with Opposer or its POST-IT brand products. Registration should therefore be refused under § 2(d) of the Lanham Act.

23. Applicant's Mark is likely to dilute the distinctiveness of Opposer's famous mark POST-IT. Registration should therefore be refused under § 43(c) of the Lanham Act.

24. Registration of Applicant's Mark would be inconsistent with Opposer's rights in the mark POST-IT and would be damaging to Opposer.

Accordingly, Opposer requests that the Board reject the Application and refuse registration of Applicant's Mark.

This Notice of Opposition is being filed electronically, along with the filing fee required by 37 C.F.R. § 2.6(a)(17). The Commissioner is authorized to draw on the Deposit Account of Pirkey Barber PLLC, Account No. 50-3924/3MTM:437/WGB, if there is any problem with the processing of the electronically submitted fee.

Date: April 27, 2015

Respectfully submitted,



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William G. Barber

Wendy C. Larson

PIRKEY BARBER PLLC

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Austin, Texas 78701

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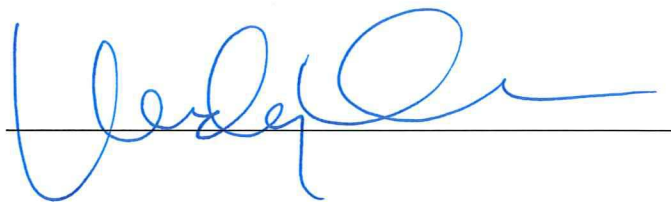
[wlarson@pirkeybarber.com](mailto:wlarson@pirkeybarber.com)

ATTORNEYS FOR OPPOSER  
3M COMPANY

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing NOTICE OF OPPOSITION has been served via First Class Mail, postage prepaid, to Applicant's attorney of record at the address below on April 27, 2015:

Lisa M. Dawson  
18 Webelo Place  
Palm Coast, FL 32164-7769

A handwritten signature in blue ink is written over a horizontal line. The signature is cursive and appears to read 'Verly' followed by a stylized flourish.